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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,059	04/26/2001	Rabindranath Dutta	AUS920010411US1	8459

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International Business Machines Corporation
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EXAMINER	
CHEN, CHONGSHAN	

ART UNIT	PAPER NUMBER
2172	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/843,059	DUTTA ET AL.	
	Examiner	Art Unit	
	Chongshan Chen	2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7-10,13-16 and 19-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7-10,13-16 and 19-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-4, 7-10, 13-16 and 19-24 are pending in this Office Action.

Response to Arguments

2. In view of the Appeal Brief filed on 17 May 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Specification

3. The title of the invention is not descriptive and too long. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4, 7-10, 13-16 and 19-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-2, 4-10, 18-24, 27-30 and 33-35 of copending Application No. 09/843,063. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: capture images and playback the captured images.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-4, 8-10, 13-16 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engle et al. ("Engle", Pub. No.: US 2004/0024640) in view of Pavley et al. ("Pavley", US 6,317,141).

As per claim 1, Engle teaches a method for displaying, at a client, transient messages received over a network, the method comprising:

storing in a chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the client (Engle, page 2, [0020]-[0022], AdCapture ... stored according to user-defined criteria, such as ... the date the ad was captured, etc., ... Ads stored in memory 24 can be sorted ... on the basis of the user-defined criteria).

Engle discloses displaying captured multimedia objects, but does not explicitly disclose displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein

the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object. Pavley discloses creating a slide show for the captured multimedia objects (Pavley, col. 2, lines 15-20). A slide show such as Microsoft PowerPoint displays a list of multimedia objects in a forward succession at a user configurable rate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a slide show presentation to display the captured multimedia objects in the system of Engle. A slide show sequentially displays all the captured multimedia objects so that the user does not need to select and play the multimedia object one at a time. It is much convenient for the user.

As per claim 2, Engle and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach each one of the plurality of different multimedia objects is at least one of an animated GIF multimedia object, a moving picture type multimedia object, a vector graphic multimedia object, and a static image multimedia object (Engle, page 2, [0020]-[0022]).

As per claim 3, Engle and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach storing at least one of the multimedia objects at the client (Engle, page 2, [0020]-[0022]).

As per claim 4, Engle and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach storing at least one of the multimedia objects at a server which is in communication over the network with the client (Engle, page 3, [0029]).

As per claim 8, Engle and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach storing at a server, which is communicatively connected over the

network with the client, each of the multimedia objects in the chronological list as each multimedia object is initially rendered at the client (Engle, page 3, [0029]).

As per claim 9, Engle and Pavley teach all the claimed subject matters as discussed in claim 8, and further teach sending a given one of the different multimedia objects from the chronological list and a corresponding software unit to enable the multimedia object to be played in response to a selection of a replay button sent from the server to be displayed at the client in conjunction with the multimedia object in an area of a document allocated to the multimedia object (Engle, page 2-3, [0020]-[0029]).

Claims 10, 13-16 and 19-20 are is rejected on grounds corresponding to the reasons given above for claims 1-4 and 8-9.

As per claim 21, Engle teaches a method for redisplaying, at a client, at least one transient message displayed in a browser, the method comprising:

identifying a region associated with the at least one transient message (Engle, page 1, [0013]);

clipping the region associated with the at least one transient message (Engle, page 1, [0013]);

storing in a chronological list, independently of a user action, each transient message when each transient message is initially rendered by the browser (Engle, page 2, [0020]-[0024]).

Engle discloses displaying captured multimedia objects, but does not explicitly disclose displaying the chronological list with control buttons for enabling a subsequent rendering of the transient messages in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed

control buttons are independent of any playback control displayed in conjunction with initially rendering a given transient message. Pavley discloses creating a slide show for the captured multimedia objects (Pavley, col. 2, lines 15-20). A slide show such as Microsoft PowerPoint displays a list of multimedia objects in a forward succession at a user configurable rate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a slide show presentation to display the captured multimedia objects in the system of Engle. A slide show sequentially displays all the captured multimedia objects so that the user does not need to select and play the multimedia object one at a time. It is much convenient for the user.

As per claim 22, Engle and Pavley teach all the claimed subject matters as discussed in claim 20, and further teach associating a separate identifier for each stored transient message; and enabling a use of the identifier for the user selection (Engle, page 2, [0024]).

Claims 23-24 are rejected on grounds corresponding to the reasons given above for claim 21.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engle et al. ("Engle", Pub. No.: US 2004/0024640) in view of Pavley et al. ("Pavley", US 6,317, 141) and further in view of Olah et al. ("Olah", US 6,446,119).

As per claim 7, Engle and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach capturing and storing multimedia objects. However, neither Engle nor Pavley explicitly disclose the storing step occurs for a configurable duration of time. Olah discloses the storing step occurs for a configurable duration of time (Olah, Fig. 2-3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made

to set up a capture time period in the system of Engle. This enables the system to only capture the multimedia objects in the user interested time period.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wynn et al. (US 6,667,751 B1) disclose linear web browser history viewer.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is 703-305-8319. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703)305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 5, 2004

SHAHID ALAM
PRIMARY EXAMINER